

REMARKS

Status of the Claims

Claims 1-8, 11, 14-17, 21, and 22 are currently pending and under examination. Claims 9, 10, 12, 13, and 18-20 have been cancelled without prejudice or disclaimer of the subject matter claimed therein. Applicants reserve the right to file one or more divisional or continuation applications directed to any cancelled subject matter.

Amendments to the Claims

Claims 1-8, 11, 14, 15, and 16 have been amended, and claims 21 and 22 have been added. Support for the amendments to the claims and the addition of the new claim can be found throughout the specification. Representative support is summarized below.

Claims 2-8 and 14 have been amended to recite “or a pharmaceutically acceptable salt or an in-vivo-hydrolysable ester thereof.” Representative support for the amendment can be found in claim 1.

Claims 2, 15, and 16 have been amended to correct grammatical errors and delete unnecessary words or phrases.

Claim 11 has been amended to recite “a method for treating a bacterial infection” and to recite the different bacteria causing the infection. Representative support for the amendment can be found on pages 53 and 54 of the specification.

Representative support for new claims 21 and 22 can be found in claim 15 as originally filed.

Applicants respectfully submit that no new matter has been introduced by these amendments.

Information Disclosure Statement

On August 8, 2005, Applicants submitted an Information Disclosure Statement along with three Form 1449 pages listing documents for the Examiner’s consideration. It appears that

the Examiner has only signed the last Form 1449 page. Applicants respectfully request that the Examiner considers the documents listed on the first two Form 1449 pages, which are enclosed with this amendment, and sign both Form 1449 pages to indicate that she has considered the listed documents.

Objection to the Claims

Claims 15-16 and 18 have been objected to for lacking periods at the end of these claims.

Claims 15 and 16 have been amended to include a period at the end of the claim. Claim 18 has been cancelled without prejudice or disclaimer of the subject matter claimed therein. Accordingly, Applicants respectfully request that the objections to claims 15 and 16 be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over HCAPLUS 53:2071f-i (Gladstein *et al.* Zhurnal Obshchei Khimii, 1958, 28, page 2107-2111).

Claim 18 has been cancelled without prejudice or disclaimer of the subject matter claimed therein. Accordingly, the rejection of claim 18 under 35 U.S.C. 103(a) is rendered moot.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-8, 11, and 14-17 are rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable the scope of the claims.

As acknowledged by the Office Action, the specification is enabling for using the compounds of formula I to treat infections caused by staphylococcus aureus, streptococcus pneumonia, Enterococcus faecium, Haemophilus influenzae, Maraxella catarrhalis, and Linezolid Resistant Streptococcus Phenumonia.

Applicants respectfully point out that claims 1-8 and 14 are directed to compounds and pharmaceutical compositions comprising compounds which the Office Action has acknowledged

as enabled by the specification for treating bacterial infections caused by the bacteria listed in the preceding paragraph. Claims 15-17 are directed to methods of producing the compounds of claims 1-8. Accordingly, claims 1-8 and 14-17 are enabled by the specification.

Claim 11, as it stands, is directed to a method of treating a bacterial infection caused by specific bacteria, which the Office Action has acknowledged as being enabled by the specification.

Accordingly, Applicants submit that the claims are enabled by the specification.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 15 and 16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Without acquiescing to the propriety of the rejection, claims 15 and 16 have been amended accordingly, as discussed below, to overcome the rejection.

A. The Office Action alleges that the phrase “by modifying a substituent in” is unclear as to what substituent would be modified. Process (a) of claim 15 has been amended to recite “converting one compound of formula (I) to another compound of formula (I). A person having ordinary skill in the art would know how to convert one compound into another using techniques routinely practiced in the art.

B. The Office Action alleges that the phrase “appropriately substituted” is unclear as to whether the limitation following the phrase are part of the claimed invention. Process (c) of claim 15 has been amended to insert the formula of an oxirane. Process (c) as amended is clear.

C. The Office Action alleges that the phrase “such as” renders the claim indefinitely as to whether the limitation following the phrase are part of the claimed invention. The phrase has been deleted from process (g) of claim 15.

D. The Office Action alleges that the limitation the “(d(i)), (d(ii)), (e(i)),” has insufficient antecedent basis. Processes (d(i)) and (d(ii)) are sub-processes of process (d). In process (d), the compound of formula (IV) undergoes one of the reactions of (d(i)) or (d(ii)). Likewise, process (e(i)) is a sub-process of process (e). In process (e), the compound of formula (XIII) undergoes the reaction of (e(i)).

It is not clear as to the reason that the Examiner has asserted that these sub-processes lack antecedent basis. Applicants respectfully request clarification of this rejection.

E. The Office Action alleges that the phrase “neat” in claim 16 renders the claim indefinite. Applicants respectfully point out that the term “neat” is known to a person of ordinary skill in the art that the reaction takes place in the absence of an inert diluent.

F. The Office Action alleges that claim 15 is incomplete because process (a) does not recite all the steps and is missing essential elements. Applicants respectfully submit that process (a) as amended is complete. Applicants also point out that a claim need not recite what is already known.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. § 112, second paragraph.

Conclusion

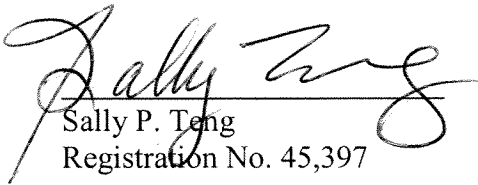
The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time

under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **June 23, 2008**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted,


Sally P. Teng
Registration No. 45,397

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Substitute for Form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>	Complete if Known	
	Application Number	10/536,687
	Filing Date	May 27, 2005
	First Named Inventor	Michael Barry GRAVESTOCK
	Art Unit	Not yet known
	Examiner Name	Not yet known
Sheet 1 of 2		Attorney Docket No. 100856-1P US

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Document Number Number - Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	
	US1	US2002/115669	August 22, 2002	Pilushchev Marina Et Al		
FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document ³ Country Code ³ - Number ⁴ - Kind Code ⁵ (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
	AA	WO 01/81350	November 1, 2001	ASTRAZENECA AB ASTRAZENECA UK LIMITED		<input type="checkbox"/>
	AB	WO 01/94342	December 13, 2001	DONG A PHARM CO LTD		<input type="checkbox"/>
	AC	WO 02/081470	October 17, 2002	ASTRAZENECA AB ASTRAZENECA UK LIMITED		<input type="checkbox"/>
	AD	WO 03/022824	March 20, 2003	ASTRAZENECA AB ASTRAZENECA UK LIMITED		<input type="checkbox"/>
	AE	WO 03/072575	September 4, 2003	ASTRAZENECA AB ASTRAZENECA UK LTD		<input type="checkbox"/>
	AF	WO 03/072576	September 4, 2003	ASTRAZENECA AB ASTRAZENECA UK LTD		<input type="checkbox"/>
Examiner Signature					Date Considered	

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	First Named Inventor	Michael Barry GRAVESTOCK
	Art Unit	Not yet known
	Examiner Name	Not yet known
Sheet 2 of 2		Attorney Docket No. 100856-1P US

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	AG	WO 03/035648	May 1, 2003	ASTRAZENECA AB ASTRAZENECA UK LTD		<input type="checkbox"/>
	AH	WO 04/048370	June 10, 2004	ASTRAZENECA AB ASTRAZENECA UK LTD		<input type="checkbox"/>
	AI	WO 04/048392	June 10, 2004	ASTRAZENECA AB ASTRAZENECA UK LTD		<input type="checkbox"/>
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